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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/022,350	12/20/2001	Christopher Peggs	PEGG3001/REF	2605
7590	05/18/2004		EXAMINER	
Richard E. Fichter BACON & THOMAS, PLLC 625 Slaters Lane Alexandria, VA 22314-1176				SCHLAK, DANIEL K
			ART UNIT	PAPER NUMBER
			3653	

DATE MAILED: 05/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/022,350	PEGGS, CHRISTOPHER	
	Examiner	Art Unit	
	Daniel K Schlak	3653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 19 February 2004.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1,5-12,16 and 17 is/are pending in the application.

4a) Of the above claim(s) 1,5-12,16 and 17 is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) _____ is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) 1,5-12,16,17 are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-12 and 16, prior to the amendment filed 2/19/04, drawn to bag splitter with flails formed of material with specific Young's modulus, classified in class 241, subclass 193.
- II. Claims 1, 5-12, 16, and 17, as amended on 2/19/04, drawn to bag splitter with whip-like cutting action, classified in class 241, subclass 193.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as offering a specific material in contact against a bag. Invention II has separate utility such as whipping bags. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

Well known in the art is a bag splitter with rotatable flail structure having a plurality of flexible flails attached to a rotatable mounting, and a waste feed guide structure.

Thus, prior to the amendment, the invention (improvement over the known device) was that the flails were of a material having a Young's modulus less than 50GN/m². This, being the invention, is what the Examiner searched, and to this art was applied in rejection.

After the amendment, the invention is now something completely different. The concept searched by the Examiner has been wholly removed. Thus, the searched invention is no longer of issue in the application.

The new (Group II) invention is a bag splitter that is allegedly different from prior art bag splitters in that it offers a "whip like cutting action". This was not searched. A new search for this is, or would be if a divisional application were filed, required. The new subject matter, given that the remaining recitations of claim 1 are known in the art, makes claim 1 into a new invention. The original (Group I) invention was allegedly different from prior art bag splitters in the material of which the flails were comprised. Thus, this application will follow upon the originally alleged novelty and cannot continue when such has been removed in lieu of a wholly different invention.

The amendmed claims are directed to an invention that is independent or distinct from the invention originally for the reasons given above.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 1, 5-12, 16, and 17 have been

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withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Applicant may bring them back into consideration by re-inserting the recitation that was removed, the recitation upon which all of the preceding action was based. Alternatively, Applicant may file a divisional application on the claims devoid of that recitation and having the new "whip like" recitation.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel K Schlak whose telephone number is 703-305-0885. The examiner can normally be reached on Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald Walsh can be reached on 703-306 - 4173. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

dko


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